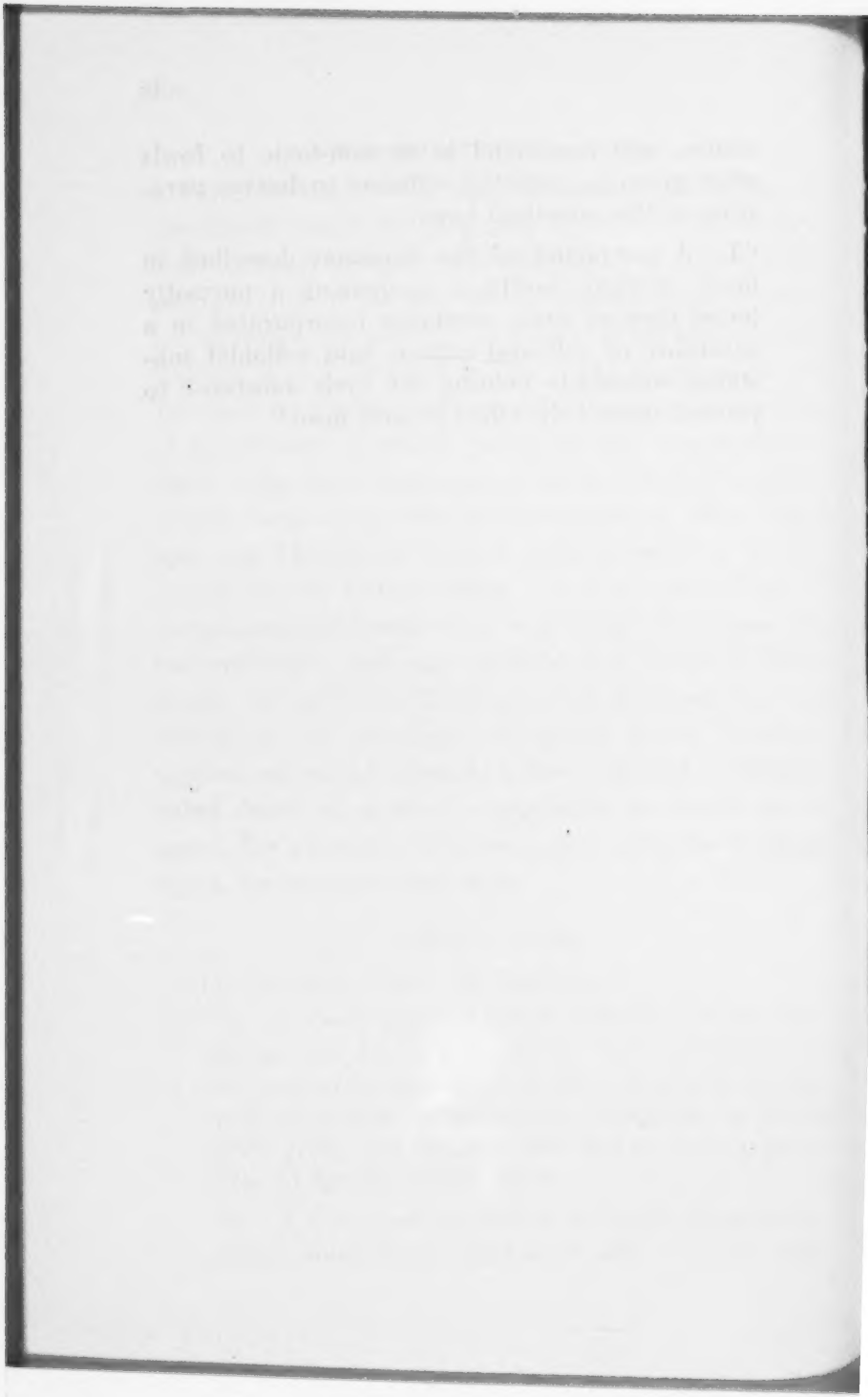

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CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

October Term, 1940

No. 401

GROVER D. TURNBOW, C. E. GRAY and LEDERLE LABORATORIES, INC., a corporation,

Petitioners,

vs.

FARMERS' COOPERATIVE EXCHANGE, INC.,

Respondent.

BRIEF FOR RESPONDENT.

FREDERICK S. LYON,
811 West Seventh Street Building, Los Angeles,
Attorney for Respondent.

Parker & Baird Company, Law Printers, Los Angeles.

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	PAGE
General Electric Co. v. Wabash Co., 304 U. S. 364	2, 3, 5
Wood v. Underhill, 5 How. 1	5

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BRIEF FOR RESPONDENT.

This is the usual patent infringement case.

There is no conflict between the decision herein and the decision of any other court respecting either the validity or scope of either of the patents involved herein.

The petition for certiorari is predicated upon a complete misinterpretation of the decision of the Court of Appeals. Said court held that both patents were anticipated and were void as disclosing no invention. Said court also stated that if either patent could be adjudged to be addressed to any invention, it must be predicated upon a discovery of critical proportions of colloidal material to be used in the composition of matter to prevent the death of the subject to which such composition was ad-

ministered; but that even if it be assumed that there was any such problem as a critical proportion of colloidal material, inasmuch as this must then constitute the "exact point of novelty," then the fact that the quantity or proportions were not set forth in the patent specifications and were included in the claims solely "in conveniently functional language" rendered the patents void under the rule of *General Electric Co. v. Wabash Co.*, 304 U. S. 364, 369. Instead, therefore, of the Court of Appeals decision being in conflict, it is a direct application of the rule of the *General Electric Co. v. Wabash Co.* decision.

The Court of Appeals herein found that the prior Dietrich patent 896,804 [Transcript of Record, Vol. IV., pp. 1209-11]; the Lloyd paper before the American Pharmaceutical Society in 1910 [*Id.*, pp. 1229-49], and the Lloyd patents 1,048,712, 1,300,747, and 1,250,331 [*Id.*, 1517, 1519, 1520], anticipated the two patents in suit unless there was patentable discovery in critical proportions of colloidal material, saying:– "It is clear, therefore, that what, if anything, was novel, was the discovery of how much colloidal material was necessary to carry out the function of preventing the alkaloidal substance from having a lethal effect on the subject to which the product was administered." [Trans. of Record, Vol. V., pp. 1570-71.] "It being apparent, therefore, that the novelty, if any, here resides in the amount of the colloidal substance used, let us examine the claims. We may assume, without so deciding, that the claims sufficiently describe the quantity of the alkaloidal substance. The quantity of colloidal substance is described only as being an amount sufficient to colloidally hold and protect against the lethal effect of the dose. Such is the exact function of the colloidal material." [*Id.*, p. 1571.] The

court held that, "The claims here violate that rule, and are void because 'conveniently functional language at the exact point of novelty' is used. Gen. Electric Co. v. Wabash Co., *supra,* * * *." The specification of neither of the two patents in suit sets forth any critical or exact proportions of colloidal substance to be used.

The petition for certiorari therefore misrepresents and misconstrues the decision of the Court of Appeals. It asserts such decision to be erroneous in two respects: (1) it is charged that the Court of Appeals held the claims to be invalid because "a patentee could not make a generic claim for a class unless he could show affirmatively that every member of that class would work" (Petition for Certiorari, top p. 6), and (2) that an entire patent was void merely where "* * * the proportions of some of such ingredients were delimited in terms of result or function * * *." (Petition for Certiorari p. 6.)

On the contrary, the Court of Appeals points out:– "In this connection, appellees in attempting to distinguish Gen. Electric Co. v. Wabash Co., *supra,* contend that 'each and every of these claims specify the ingredients as well as the quantity or proportion of such ingredients.' *We are unable to agree with that contention.** An entire *class*** of ingredients is specified not specific 'ingredients.' *The quantity or proportion of the class** is not specified except 'in conveniently functional language.'" [Trans. of Record, Vol. V., p. 1572.]

In attempting to construct a conflict in the rule or principle of law applied by the Court of Appeals with

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* Emphasis ours; ** emphasis by the court.

other decisions, petitioner has ignored entirely the next to the last paragraph of the opinion, to wit:—

> "The instant case is one illustrative of the practice followed in many patents. The inventors experimented with and compounded particular alkaloidal substances with particular colloidal substances. Instead of confining their claims to that which they actually discovered, if anything, they attempted to monopolize all parasiticides which could be made from the entire class of alkaloidal substances with the entire class of colloidal substances. We think the patent law is not so benevolent, *and although we do not base our decision on that express ground, we mention it* to refute suggestions that the issuance of a patent offers no protection to a patentee." [*Id.*, p. 1572.] (Emphasis ours.)

The decision of the Court of Appeals is grounded upon its finding that nothing new was disclosed in either of the patents in suit; that neither patent describes in the specification or sets forth in the claims any critical proportion of colloidal material; that the use of alkaloidal substances and of colloidal substances was well known; that the principle of adsorption and absorption of alkaloidal substance by colloidal substance was well known, as well as the chemical fact that where alkaloidal substances are adsorbed or absorbed by colloidal substances, the alkaloidal substance is not released in the digestive tract until the compound passes to the alkaline portion of the tract, the alkalinity of which frees or dissociates

the elements. The Court of Appeals, speaking of the prior Lloyd patent, found therein:

> "* * * the exact theory upon which the patents in issue are based, as shown by the following quotations therefrom:
>
> " 'I have discovered that certain insoluble clays or compounds of magnesium when mixed with certain alkaloids or alkaloidal salts, will adsorb them and prevent their going into solution in water or liquids which are acidulated even to a slight degree, but that in liquids which are alkaline even to a slight degree, such alkaloidal substances will go into solution.
>
> " 'The contents of the stomach are usually slightly acid, whereas the intestines are slightly alkaline. Hence the alkaloidal compounds of my invention will pass through the stomach, without the alkaloids or alkaloidal salts being dissolved, and in the intestines the alkaloids or alkaloidal salts will be dissociated.' " [*Id.* p. 1563.]

The Court of Appeals' opinion is predicated upon an exact following and application of the decisions of this Court in *General Electric Co. v. Wabash Co. (supra)* and *Wood v. Underhill*, 5 How. 1, in which latter decision this Court says:–

> "But when the specification of a new composition of matter gives only the names of the substances which are to be mixed together, *without stating any relative proportion, undoubtedly it would be the duty of the court to declare the patent to be void. And*

*the same rule would prevail where it was apparent that the proportions were stated ambiguously and vaguely. For in such cases it would be evident on the face of the specification, that no one could use the invention without first ascertaining, by experiment, the exact proportion of the different ingredients required to produce the result intended to be obtained. * * * And if, from the nature and character of the ingredients to be used, they are not susceptible of such exact description, the inventor is not entitled to a patent."* (Emphasis ours.)

The decision of the Court of Appeals presents no question justifying the grant of the writ of certiorari.

Respectfully submitted,

FREDERICK S. LYON,
Attorney for Respondent.